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MAIL STOP APPEAL BRIEF - PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellants: Frank J. McConnell et al. Attorney Docket No. SACO115537
Application No.: 09/658,770 Group Art Unit: 3626
Filed: September 11, 2000 Examiner: Natalie Pass
Title: METHOD AND SYSTEM FOR PROVIDING INSURANCE POLICIES VIA
A DISTRIBUTED COMPUTING NETWORK

TRANSMITTAL OF APPELLANTS' APPEAL BRIEF

February 22, 2005

TO THE COMMISSIONER FOR PATENTS:

A. Appeal Brief

Enclosed is Appellants' Appeal Brief.

The required fee of \$500 is included in our enclosed Check No. 161617.

B. Additional Fee Charges or Credit for Overpayment.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.18 which may be required during the entire pendency of the application, or credit any overpayment, to Deposit Account No. 03-1740. *A copy of this sheet is enclosed.*

Respectfully submitted,

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CERTIFICATE OF MAILING

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Date: February 22, 2005

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MAIL STOP APPEAL BRIEF - PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: Frank J. McConnell et al. Attorney Docket No. SACO115537
Application No: 09/658,770 Group Art Unit: 3626
Filed: September 11, 2000 Examiner: Natalie Pass
Title: METHOD AND SYSTEM FOR PROVIDING INSURANCE POLICIES VIA
A DISTRIBUTED COMPUTING NETWORK

APPELLANTS' APPEAL BRIEF

February 22, 2005

TO THE COMMISSIONER FOR PATENTS:

For nearly 80 years, Safeco Insurance Company of America (hereinafter "Safeco") sold its insurance policies solely through independent agents. On-line sales of insurance policies through the Internet threatened this business model by supplanting the independent agents. Unlike the impersonal experience of on-line sales of insurance policies, each independent agent can strengthen the customer relationship, which translates to additional sales of insurance policies. The claimed invention allows Safeco to enjoy additional sales generated by the independent agents' efforts and increased renewals of insurance policies without alienating thousands of independent agents by selling on-line insurance policies in competition with them.

The Examiner erroneously denied the above-identified patent application, citing references that do not reintermediate independent agents. Appellants submit this Brief in support of the Notice of Appeal filed on January 7, 2005, to the Board of Patent Appeals and Interferences appealing the decision, dated November 1, 2004, of the Primary Examiner finally rejecting Claims 1, 3-8, and 10-19. A reversal of the decision of the Examiner and issuance of the patent application is respectfully requested.

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I. REAL PARTY IN INTEREST

The subject application is owned by Safeco Insurance Company of Seattle, Washington.

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II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, Appellants do not have any knowledge of related appeals or interferences that may directly affect or have a bearing on the decision of the Board of Appeals and Interferences (hereinafter "the Board") in the pending Appeal.

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III. STATUS OF CLAIMS

On September 11, 2000, Appellants filed the pending patent application including Claims 1-19. On March 3, 2003, the Examiner issued a first Office Action rejecting Claims 1-19. On May 28, 2003, Appellants filed an Amendment and Response in which Claims 1, 3-6, 8, 10, 14, and 19 were amended and Claims 2 and 9 were canceled. On August 12, 2003, the Examiner issued a second Office Action, finally rejecting Claims 1, 3-8, and 10-19. An Appeal followed on November 4, 2003, and an Appeal Brief was filed on March 4, 2004. On May 19, 2004, an Examiner's Answer was issued, and a Supplemental Appeal Brief was filed in response on June 18, 2004. A Request for Continued Examination followed on August 11, 2004, requesting further prosecution to address issues raised in the Examiner's Answer. The Examiner issued another final Office Action on November 1, 2004, finally rejecting Claims 1, 3-8, and 10-19.

This Appeal follows in which Appellants entreat the Board to reverse the final rejection of Claims 1, 3-8, and 10-19. The claims on appeal are set forth in Appendix VIII.

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IV. STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection.

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V. SUMMARY OF CLAIMED SUBJECT MATTER

Prior to discussing Appellants' invention, Appellants set forth a brief background of the invention to help the Board better appreciate Appellants' invention. The following background and the discussions of the disclosed embodiments of Appellants' invention are not provided to define the scope or interpretation of any of the appealed claims.

A. Background of the Invention

Web sites are now available that provide insurance services, such as non-binding premium quotations. Other Web sites allow a customer to actually purchase a policy. Traditionally, insurance policies have been sold either through insurance agents or directly to a consumer. Many insurance companies have typically relied on insurance agents as a first point of contact with customers and to enhance the value of the insurance policies provided by the insurance companies. Many Internet Web sites that provide insurance products have supplanted these insurance agents by selling insurance policies directly to the consumer. While these Web sites may pay a commission to an agent for the sale, the insurance companies that operate such sites retain control over the customer's account to the exclusion of the selling agent.

Paying insurance agents a commission for an on-line sale of an insurance policy without releasing control of the customer's account to the agent is a myopic business strategy for an insurance company. In the long term, this strategy may have many drawbacks. For instance, customers may not receive the level of personalized service and value they once received because insurance agents may be unmotivated to provide additional service (if they will not receive monetary compensation).

An insurance company that forgoes on-line purchases risks losing many sales from customers who prefer buying on-line. But selling insurance policies both on-line and through independent agents puts insurance companies in a difficult position of competing with independent agents. This competition may alienate independent agents that have traditionally

sold insurance products of the insurance company and thereby, the insurance company loses traditional sales, which can account for a great bulk of insurance policies sold. For these and other reasons, selling insurance policies directly to consumers through an Internet Web site without completely re-intermediating an insurance agent by providing complete control of the customer's account to the agent is not a desirable business model.

B. Summary of an Exemplary Subject Matter

Appellants' invention is directed to avoiding or reducing the above problems by providing a method and system for providing insurance policies via a distributed computing network that receives a request from a customer to purchase an insurance policy according to a bindable insurance premium quotation, and in response to such a request, re-intermediating an insurance agent and issuing the insurance policy. The prospective customer may purchase the insurance policy according to a provided bindable premium quotation through a Web site. If the prospective customer elects to purchase the policy, the Web site may re-intermediate an insurance agent into the sales process. The insurance agent may be re-intermediated by first providing a list of available insurance agents to the prospective customer. The prospective customer may select one of the insurance agents from the list. Once an agent has been selected, complete control of the customer's account is transferred from the Web site to the selected agent. To accomplish this, information regarding the prospective customer and the insurance policy is transmitted to the insurance agent. Using this information, the insurance agent may make direct contact with the customer and provide value-added services to the customer. Additionally, the insurance agent receives a commission for his services.

The list of insurance agents provided to the prospective customer may be compiled based on the geographical distance between the agents and the customer. For instance, the insurance agents closest to the purchaser's home may be identified and displayed. Similarly, the customer may indicate that the insurance agent geographically closest to his address should be assigned to

service the policy. Once an insurance agent has been re-intermediated in this manner, the insurance policy and any accompanying documents may be delivered to the customer in electronic form.

C. Explanation of Various Subject Matters Defined in the Claims

Independent Claim 1 is directed to a method for providing an insurance policy via a distributed computing network. See the pending specification at pages 4, 7, 8, 11, and 18; and FIGURE 12. The method is recited as comprising an act for receiving a request for a bindable premium quotation for an insurance policy; and in response to said request, another act for receiving information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy. The method further comprises an act for gathering underwriting information from one or more outside information resources based upon the identity of said individual. The method further comprises an act for determining whether said insurance policy may be underwritten, and in response to determining that the said insurance policy may be underwritten, another act for calculating a premium for said insurance policy and providing said premium to the requestor of said premium quotation as a bindable insurance premium quotation. The method additionally recites an act for receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy.

Claims 3-7 are dependent from independent Claim 1 and are directed to further limitations of the method described above. Claim 3 is dependent on Claim 1 and recites that the act of issuing said insurance policy comprises an act of transmitting an electronic version of said insurance policy to an individual insured by said insurance policy. Claim 4 is dependent on Claim 1 and recites that the act of re-intermediating an insurance agent comprises an act of providing a list of available insurance agents; another act of receiving the selection of a selected

agent from the list of available insurance agents; a further act of assigning said selected insurance agent to said insurance policy; and a further act of transmitting information regarding said individual and said insurance policy to said selected insurance agent; and an additional act of remitting a commission to said selected insurance agent.

Claim 5 is dependent on Claim 1 and recites that the act of re-intermediating an insurance agent comprises an act of providing a list of available insurance agents. The available insurance agents are identified based upon their geographical proximity to said individual. The method of Claim 5 further recites an act of receiving the selection of a selected agent from the list of available insurance agents; a further act of assigning said selected insurance agent to said insurance policies; a further act of transmitting information regarding said individual and said insurance policy to said selected insurance agent; and an additional act of remitting a commission to said selected insurance agent. Claim 6 is dependent on Claim 1 and recites that the act of re-intermediating an insurance agent comprises an act of assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; a further act of assigning said assigned insurance agent to said insurance policy; a further act of transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and an additional act of remitting a commission to said assigned insurance agent. Claim 7 is dependent on Claim 6 and recites that the said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

Independent Claim 8 is directed to a system for providing an insurance policy via a distributed computing network. See the pending specification at pages 6, 7, 8, 11, 18, and 20; and FIGURE 3. This system is recited as comprising a server computer, which maintains a virtual insurance producer Web site available via said distributed computing network. The virtual producer Web site is operative to receive a request for a bindable premium quotation for an insurance policy, information relating to the insurability of an individual to be insured by said

insurance policy, and information relating to the coverage to be provided by said insurance policy in response to said request. The virtual producer Web site is further operative to gather underwriting information from one or more outside information resources based upon the identity of said individual and determine whether said insurance policy may be underwritten. The virtual producer Web site is additionally operative to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation. The virtual producer Web site is also operative to receive a request to purchase said insurance policy according to said bindable insurance premium quotation, re-intermediate an insurance agent, and issue said insurance policy.

Claims 10-18 are dependent from independent Claim 8 and are directed to further limitations of the system described above. Claim 10 is dependent on Claim 8 and recites that the virtual producer Web site is further operative to provide an interactive help system to a requestor of said insurance policy. Claim 11 is dependent on Claim 10 and recites that the interactive help system comprises an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative. Claim 12 is dependent on Claim 11 and recites that the interactive help system further comprises an e-mail facility for providing an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative. Claim 13 is dependent on Claim 12 and recites that the interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance. Claim 14 is dependent on Claim 8 and recites that the virtual producer Web site is further operative to issue said insurance policy, which comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy. Claim 15 is dependent on Claim 14 and recites that the virtual producer Web site is further operative to re-intermediate an insurance agent, which comprises providing a list of

available insurance agents; receiving the selection of a selected agent from the list of available insurance agents; assigning said selected insurance agent to said insurance policy; transmitting information regarding said individual and said insurance policy to said selected insurance agent; and remitting a commission to said selected insurance agent. Claim 16 is dependent on Claim 14 and recites that the virtual producer Web site is further operative to re-intermediate an insurance agent, which comprises providing a list of available insurance agents. The available insurance agents are identified based upon their geographical proximity to said individual. Claim 16 further recites receiving the selection of a selected agent from the list of available insurance agents; assigning said selected insurance agent to said insurance policy; transmitting information regarding said individual and said insurance policy to said selected insurance agent; and remitting a commission to said selected insurance agent. Claim 17 is dependent on Claim 14 and recites that the virtual producer Web site is operative to re-intermediate an insurance agent; by assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; assigning said assigned insurance agent to said insurance policy; transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and remitting a commission to said assigned insurance agent. Claim 18 is dependent on Claim 17 and recites that the assigned insurance agent comprises the geographically closest available insurance agent to said customer.

Independent Claim 19 is directed to a computer-readable medium. See the pending specification at page 5, among other places. The computer-readable medium is recited as comprising computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 1, 3, 4, 5, 6, or 7.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by the teachings of U.S. Patent No. 5,537,315, issued to Mitcham (hereinafter "Mitcham"). In addition, Claims 4-8 and 10-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of the teachings of Mitcham, taken in view of the teachings of the CNA Customer Services State Sales Offices Web site, http://web.archive.org/web/20000311214508/www.cna.com/group/custserv/gr_stat.html (hereinafter "CNA reference"), and further in view of the teachings of the MostChoice Advisor Web site, http://web.archive.org/web/20000818065246/www.mostchoice.com/General/Advisor_Center/Why/G_Adv_Why_Overview.cfm (hereinafter "MostChoice reference").

VII. ARGUMENT

As discussed below, the Examiner has failed to establish a *prima facie* case of anticipation and obviousness. To establish *prima facie* anticipation of a claimed invention, each and every element arranged as in the claim must be found in a single prior art reference. *See* M.P.E.P. § 2131. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, as indicated by M.P.E.P. § 2143.03. The applied references do not teach the concept of receiving a request to purchase an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy. Nor do the applied references teach the concept of transmitting an electronic version of the insurance policy to an individual insured by the insurance policy. Moreover, Mitcham, the CNA reference, and the MostChoice reference, cannot be combined without destroying the operation of all references. For better appreciation of the arguments below, Appellants summarize each applied reference.

A. Summary of the References

1. Summary of Mitcham

Mitcham allows a user to independently create a binding insurance agreement. *See* Col. 4, lines 9-12. But the similarity ends there. In Mitcham, creation of the binding insurance agreement occurs "without the need for interacting with a representative of an insurance company" (emphasis provided). *See* Col. 4, lines 10-11. Mitcham distinguishes between a representative of an insurance company and an independent agent. Mitcham describes a system for computerized procurement of quotes from a number of insurance companies and completely lacks the process of reintermediating an independent agent to potentially generate additional sales and strengthen the customer relationship so that the customer is more likely to renew the insurance policy with the insurance company.

As described by Mitcham at Figure 3C, after the user has entered various personal information, the system of Mitcham determines the lowest rate for each level of insurance coverage for the user. For example, the minimum level of coverage may include only those levels required by a particular state. Next, the system of Mitcham determines the identity of the insurance company providing the lowest rate for levels of coverage. The company name and the associated rate are then stored. If the insurance company does not want its name to be displayed on the kiosk, only the coverage limit and rate for each level of coverage are displayed. Otherwise, the coverage limit, rate for each level, as well as the name of the insurance company, are displayed on the kiosk. Next, the system of Mitcham allows the user to select the level of coverage that the user desires. Once a level of coverage is selected, the system of Mitcham displays various options. See Col. 6, lines 20-25. Thus, the distinguishing difference between the system of Mitcham and the present invention is the lack of receiving a request to purchase an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy.

Figure 3D of Mitcham illustrates the logic of the options presented to the user. Four options are available to the user. First, the user can elect to complete the contract (in other words, to request to purchase an insurance policy). Second, the user can elect to have a representative of an insurance company (not an insurance agent) contact the user. Note the logic of completing the contract in the system of Mitcham is separated from the logic of electing to have a representative of the insurance company contact the user. Third, the user can elect to print an insurance quote. Fourth, the user may elect to exit from the on-line insurance purchase process. Figure 3D of Mitcham crystallizes the distinguishing difference between the claimed invention and the system of Mitcham. The logic path of the option to complete the insurance contract is completely separate from the logic path in which the user requests that a representative of an insurance company contact the user.

2. Summary of the CNA Reference

The CNA reference at page 13 describes that insurance is sold through independent agents and brokers across America, whose Web sites can be found on an agent locator page. To locate a CNA branch office, according to page 11 of the CNA reference, a map is used by a user to locate a particular state from which the address of local CNA sales offices will be displayed to the user. Unlike the present invention, no method of providing an insurance policy via a distributed computing network is taught or even suggested by the CNA reference.

There can be no re-intermediation in the system described by the CNA reference because the user must first track down a CNA insurance agent before the CNA insurance agent can help the user obtain an insurance policy. The system of the CNA reference is no different than the traditional approach of looking up an insurance agent in the yellow pages and calling the insurance agent.

3. Summary of the MostChoice Reference

The MostChoice reference is a collection of Web pages of a Web site allowing a user to apply for an insurance policy or talk to "local advisors" regarding the insurance policy. Page 1 of the MostChoice reference illustrates a table with two columns. The first column is described by the MostChoice reference as the offerings of independent insurance agents. In the second column of the table, the MostChoice reference distinguishes the offerings of independent insurance agents from "local advisors," who provide more services than those of independent insurance agents.

On page 1 of the MostChoice reference, the following is discussed:

You can see that using a local advisor makes a lot of sense, and in fact that some of our on-line only competitors are misleading you by implying that it is cheaper and easier to do it all yourself online. Hey, but then again you don't have to use an advisor at all if it bothers you! You can apply online with us and barely talk to anyone at all during the process.

(Emphasis provided.)

Through Appellants' attorneys, an attempt was made to apply for an insurance quote on-line at the Web site "www.mostchoice.com" archived at the Web site "web.archive.org." Instead of receiving a Web page for filling out information to obtain an insurance quote, Appellants received a Web page displaying the text "Under Construction." One of the reasons that the MostChoice reference cannot teach or suggest the claimed invention is because a user could not use the MostChoice reference to obtain a bindable insurance premium quotation at the time the claimed invention was made. The Web page of the MostChoice reference that would have allowed only a quote was still "under construction." Thus, it is not possible for the MostChoice reference to receive a request to purchase an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy. The present-day Web site "www.mostchoice.com" continues to not allow anyone to request an insurance policy according to a bindable insurance premium quotation, and in response to the request, re-intermediating an insurance agent and issuing the insurance policy. No re-intermediating process is taught or suggested by the MostChoice reference. Users would have to connect to the local advisors first, similar to the process described by the CNA reference.

B. Rejection Under 35 U.S.C. § 102(b) in View of the Teachings of Mitcham

1. Claims 1 and 19

Focusing on Claims 1 and 19, the applied references do not teach or suggest providing an insurance policy via a distributed computing network while facilitating the re-intermediating of an insurance agent, and issuing said insurance policy as recited in Claim 1. The Examiner unduly focused on the features of on-line sales of insurance policies and neglected to pay attention to the essence of the claimed invention as recited in Claim 1, which is the enhancement and strengthening of the customer relationship with an insurance company by an insurance agent.

Claim 1 succinctly defines the method as comprising receiving a request for a bindable premium quotation for an insurance policy, and in response to said request, receiving information relating to the insurability of an individual to be insured by said insurance policy as well as information relating to the coverage to be provided by said insurance policy. Moreover, Claim 1 recites an act of gathering underwriting information from one or more outside information resources based upon the identity of said individual. Furthermore, Claim 1 recites an act of determining whether said insurance policy may be underwritten, and in response to determining that said insurance policy may be underwritten, another act for calculating a premium for said insurance policy and providing said premium to a requestor in the form of a bindable insurance premium quotation. Additionally, the remaining recitations of Claim 1 are directed to an act for receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, an act for re-intermediating an insurance agent and issuing said insurance policy. The applied references do not teach the concept of receiving a request to purchase an insurance policy according to a bindable insurance premium quotation, and in response to said request re-intermediating an insurance agent and issuing an insurance policy, among other things, as recited in Claims 1 and 19.

- a. The Examiner Has Failed to Establish a *Prima Facie* Case of Anticipation by Neglecting to Show That Every Claim Limitation Is Taught by Mitcham

At least two claim limitations are not taught or suggested by Mitcham. First, the system of Mitcham completely lacks the feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in Claim 1. In contrast, the system of Mitcham either allows the user to complete the insurance contract or a representative of an insurance company to contact the user—but not "receiving a request to

purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in Claims 1 and 19.

Second, Mitcham fails to teach or suggest the use of a bindable insurance premium quotation. At one point, the Examiner argues that Mitcham teaches the concept of re-intermediating, citing the following portion of Figure 13 in Mitcham: "[n]o sales call will be made without your request. To purchase your policy, please contact [a representative of an insurance company] at [a shown phone number]." See the November 1, 2004, final Office Action, at page 18. To fully and fairly understand what Mitcham actually teaches, Appellants have set forth in full the cited portion of Mitcham:

No policy has been issued; this is an informational quotation only. Changes in coverage will affect this proposal and premium amounts quoted. No sales call will be made without your request. To purchase your policy, please contact AUTOSURE at (214) 325-3001.

(Emphasis provided.) See Figure 13 of Mitcham. From this passage of Mitcham, it is clear that Mitcham does not provide a bindable insurance premium quotation.

As noted above, one step of the claimed invention is "providing a ... bindable insurance premium quotation" as recited in Claims 1, 8, and 19. From the passage quoted above, it is clear that no bindable insurance premium quotation is provided by Mitcham at Figure 13. As clearly stated by Mitcham, the quotation provided by Mitcham is "an informational quotation only." Moreover, Figure 13 illustrates a screen displayed by the program of Mitcham after the execution of block 246. See Mitcham at Col. 6, lines 16-20. The execution of block 246 occurs before block 248, and before other portions of the program of Mitcham, to complete an insurance contract.

The Examiner explained her reasoning for not disclosing the above-cited portion of Mitcham in full: "it is Examiner's interpretation that if Mitcham were publishing rates that were

not purchasable or bindable ... then the information published in Figure 13 would represent a fraudulent offering." See page 20 of the final Office Action, November 1, 2004. The Examiner's failure to use the ordinary skills of the insurance art leads her to the wrong conclusion. Insurance companies and independent agents commonly offer nonbindable, informational quotation to prospective customers based upon limited, preliminary information. If the nonbindable, informational quotation is in the customer's "ballpark," a formal application process ensues requiring detailed information. Mitcham's kiosk only offered informational quotes, which are not bindable. In contrast, the claimed invention gathers detailed information from a customer, resulting in a bindable insurance premium quotation. One with ordinary skill in the insurance art knows that a nonbindable, informational quotation is different from the "bindable insurance premium quotation," as recited in Claims 1 and 19. The Examiner improperly interprets a nonbindable, informational quotation of Mitcham as a bindable insurance premium quotation, and then relied on that wrong interpretation to reject Claims 1 and 19.

b. To Anticipate an Invention, the Prior Art Must Teach the Identical Invention

Mitcham teaches nothing about reintermediating an insurance agent in response to a request to purchase an insurance policy according to a bindable insurance premium quotation. As specified by M.P.E.P. § 2131.01, "The identical invention must be shown in as complete detail as is contained in the ... claim," citing favorably *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) (emphasis provided). Because the Examiner has failed to show that Mitcham discloses the identical invention as claimed by Appellants, no *prima facie* case of anticipation has been established by the Examiner.

Ignoring *Richardson*, the Examiner has refused to recognize that the identical invention need be taught but that to anticipate a claim, the reference must teach every element of the claim. The problem is that the Examiner is trying to distinguish between "identical invention" and

"every element of the claim." But there is no difference. A reference cannot teach every element of the claim if it does not teach the identical invention. This is the case with Mitcham because Mitcham does not teach the identical invention and therefore cannot teach every element of the claim.

Every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), citing *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 895, 221 U.S.P.Q. 669, 673; *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771-72, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026, 79 L. Ed. 2d 687, 104 S. Ct. 1284 (1984). Moreover, the identical invention must be shown in as complete detail as is contained in the patent claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920.

The Examiner has intimated that the Mitcham reference need not teach every element of the claimed invention, arranged as in the claims. That is incorrect. The Examiner also has intimated that the Mitcham reference need not disclose the identical invention. That is also incorrect. There is no legal precedent to support the Examiner's position. The Examiner cites *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d (BNA) 1051, to support the Examiner's position that it is not necessary to teach every element of the claimed invention, arranged as in the claims, or that it is not necessary to teach the identical invention. A closer review of *Verdegaal* reveals that the portion of *Verdegaal Bros., Inc. v. Union Oil Co.*, cited by the Examiner, references *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 U.S.P.Q. 781, 789 (Fed. Cir. 1983), which requires that a party asserting that a patent claim is anticipated under 35 U.S.C. § 102 must demonstrate, among other things, identity of invention.

Additionally, 35 U.S.C. § 103(a) recites that "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title," (emphasis provided) signifying conclusively that Section 102 requires identical disclosure or

description. M.P.E.P. § 1504.02 recites that "[i]n design patent applications, the factual inquiry in determining anticipation over a prior art reference is the same as in utility patent applications. That is, the reference 'must be identical in all material respects.'" (emphasis provided). M.P.E.P. § 2122 recites that "[i]n order to constitute anticipatory prior art, a reference must identically disclose the claimed compound" (emphasis provided). Because the Examiner has failed to show that Mitcham discloses every element of the claimed invention, arranged as in the claims, or the identical invention, no *prima facie* case of anticipation has been established.

c. Only Through A Distortion of The Teachings of Mitcham Can the Examiner Argue Identity of Invention

The system of Mitcham, through a kiosk, executes a program that prompts the user to enter required information in order to calculate an insurance rate. Among a variety of screens, one screen provides options for completing an application, having a representative of an insurance company contact the user, printing a quote of the selected level of coverage, or exiting the program. See Mitcham at Col. 6, lines 20-25. This portion of Mitcham is cited as providing the necessary teaching to anticipate Appellants' claimed invention. To understand why Appellants disagree, it is necessary to understand the appropriate section of the program executed by the system of Mitcham.

If the user of the Mitcham system decides to complete the insurance contract, the user can use the kiosk of Mitcham to complete it. See Figures 3E-3G. If the user decides otherwise, the user may then select the option of allowing a representative of an insurance company to contact the user. Mitcham provides no way of reintermediating an insurance agent in response to a request to purchase an insurance policy based on a bindable insurance premium quotation. Mitcham's option to contact occurs well after the completion of the insurance contract by the looping of the program to decision block 318 from the continuation terminal H. Thus, the system of Mitcham fails to provide the feature of "receiving a request to purchase said insurance policy

according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1 and 19.

In the Examiner's Final Office Action, the Examiner argued that terminal E causes the program of Mitcham to exit and not continuation terminal H. According to the Examiner, for this reason the option to contact does not occur "well after the completion of the insurance contract" but rather is an integral part of Mitcham's invention. See page 15 of the Examiner's Answer. This characterization of Mitcham is misleading. Appellants have couched terminal H as an egress of the program flow from the process diagrams illustrated in Figures 3E-3G of Mitcham. As explained by the Appellants, from terminal H (originating from Figure 3G and terminating at Figure 3D) the program of Mitcham loops back to decision block 318, among other decision blocks, allowing the user to select the option for a representative of an insurance company to contact the user. This option to contact occurs well after the completion of the insurance contract by the looping of the program to decision block 318 from terminal H. The Examiner's argument simply ignores Figure 3G, which shows the program flow entering terminal H and looping back to the decision block 318 at Figure 3D. Thus, the system of Mitcham fails to provide the feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1 and 19.

The Examiner cites Col. 6, lines 19-24, of Mitcham to support her assertion that Mitcham teaches the claimed feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy." That portion of Mitcham describes block 248

of Mitcham. Block 248 describes a user interface where there are a number of choices for a user to make. Below is the actual recitation of the portion of Mitcham at Col. 6, lines 19-24:

Next, the process passes to block 248 which illustrates the displaying of options. The options may include completing an application, having a representative of the company contact the user, printing a quote of the selected level of coverage, or exiting the program.

(Emphasis provided.)

The term "or" in the above quote makes it clear that there is a choice to be made, but only one choice. This is clarified in Figure 3D of Mitcham. Figure 3D shows four decision blocks that implement the user interface of block 248 in Figure 3C. The four decision blocks force the user to select a single choice but not two choices at once. The Examiner's reading of Mitcham leads to an illogical result that contradicts the express teachings of Mitcham. For example, if Mitcham were to allow a user the choice of completing an insurance contract and (simultaneously) the choice of having a representative of the company contact the user (as asserted by the Examiner), then a user could also choose to complete an insurance contract at the exact same time the user exits the program. Mitcham no more allows this than it allows an insurance contract to be completed simultaneously with the choice of having a representative of the company contact the user.

The Examiner focused unnecessarily on the option of exiting the program. It does not matter. The Examiner fails to explain what happens after a user decides to complete an insurance contract (the execution of the YES branch of the decision block 250.) Recall that one feature among other features of Claim 1 is "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy." Mitcham, after receiving the request to complete an insurance contract, forces the program flow to complete the insurance contract (i.e., enter continuation terminal D). The Examiner has not explained what transpires

beyond this point. But Figures 3E-3G of Mitcham do. They explain the program flow after the method enters continuation terminal D. Figures 3E-3G reveal that the insurance contract is completed without re-intermediating an insurance agent let alone an option to have an insurance agent contact the customer.

It is true that the program flow will enter continuation terminal H to loop back to Figure 3D where the user can allow a representative of the company to contact the user (i.e., execution of decision block 318). But this does not occur until well after an insurance contract is completed. On the other hand, the user may initially decide to allow a representative of the company to contact the user (i.e., to execute decision block 318), but in this case it is not in response to the act of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation," as recited in Claim 1. What Mitcham teaches is akin to the traditional approach of calling an insurance representative after looking at a business directory like the yellow pages.

The Examiner argued that nothing in Mitcham precludes selection of more than one option and that all options remain available as long as the user does not select exit. None of the options would lead to the claimed invention. Selection of decision block 250 of Mitcham would lead to the completion of an insurance contract without re-intermediation of an insurance agent. Selection of decision block 318 of Mitcham would lead to the representative of the company contacting the user without receiving first a request to purchase said insurance policy according to a bindable insurance premium quotation.

As noted above, the system of Mitcham completely lacks the feature of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claim 1. In contrast, the system of Mitcham either allows the user to complete the insurance contract or have a representative of an insurance company contact the

user—but Mitcham does not include a step of "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" as recited in Claims 1 and 19.

2. Claim 3

Claim 3 is dependent on Claim 1 and recites that the act of issuing said insurance policy comprises an act of transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

The Examiner's understanding of the claim is revealed on page 4 of the final Office Action, November 1, 2004: "wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy, or issuing the policy-on-the-spot, to an individual insured by said insurance policy." Nothing in Claim 3 requires "issuing the policy-on-the spot." Instead, the claimed invention as recited by Claim 3 requires "transmitting an electronic version of said insurance policy to an individual insured by said insurance policy." In other words, the claimed invention as recited by Claim 3 describes what happens after the insurance policy has been sold. Mitcham fails to disclose this feature of Claim 3. Mitcham's step of "issuing the policy-on-the-spot" does not anticipate the claimed step of "transmitting an electronic version of said insurance policy."

The Examiner also cited Mitcham at Figure 4; and Col. 3, line 61, to Col. 4, line 32, teaching the claimed invention as defined by Claim 3. No where in Figure 4 does Mitcham teach "transmitting an electronic version of said insurance policy to an individual insured by said insurance policy." Mitcham at Col. 3, line 61, to Col. 4, line 32, teaches only that "[t]his [insurance agreement] may be in a traditional hardcopy form printed on paper by printer 20, or it may be kept as an electronic document stored, for example, in data storage system 26." This portion of Mitcham doesn't teach the claimed "transmitting an electronic version of said

insurance policy to an individual insured by said insurance policy." While an electronic document is stored by Mitcham, Mitcham does not teach that the electronic document is transmitted or that it is transmitted to an individual insured by an insurance policy.

Appellants incorporate by reference the arguments discussed in connection with Claims 1 and 19 as if the discussed arguments were set forth in full herein.

C. Rejection Under 35 U.S.C. § 103(a) in View of the Teachings of Mitcham, the CNA Reference, and the MostChoice Reference

1. Claim 4

Claim 4 is dependent on Claim 1 and recites that the act of re-intermediating an insurance agent comprises an act of providing a list of available insurance agents; another act of receiving the selection of a selected agent from the list of available insurance agents; a further act of assigning said selected insurance agent to said insurance policy; and as yet a further act of transmitting information regarding said individual and said insurance policy to said selected insurance agent; and an additional act of remitting a commission to said selected insurance agent.

The Examiner has indicated that Mitcham fails to disclose the features recited in Claim 4 but asserts that the CNA reference teaches the method recited in Claim 4. Appellants respectfully disagree for the following reasons: To locate a CNA branch office, according to page 11 of the CNA reference, a map is used by a user to locate a particular state where the addresses of local CNA sales offices will then be displayed to the user. Assuming, for the sake of argument, that the CNA reference discusses the act of providing a list of available insurance agents, the CNA reference does not perform the act of "assigning said selected insurance agent to said insurance policy," among other limitations of Claim 4. The user has to locate the CNA branch office agent himself. The CNA Web site does not assign a selected agent to an insurance policy. Because the CNA reference does not teach or suggest the features of Claim 4, its combination with Mitcham cannot render obvious Claim 4.

Appellants incorporate by reference the arguments discussed in connection with Claim 1 as if the discussed arguments were set forth here in full.

- a. To Combine, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, and the Combination Would Destroy the Operation of All the References

As discussed above, Mitcham fails to teach "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" among other limitations, as recited in Claims 1 and 19. A user cannot request to purchase an insurance policy according to a bindable insurance premium quotation through the Web site described by the CNA reference. There can be no re-intermediation in the system described by the CNA reference because the user must first track down a CNA insurance agent before the CNA insurance agent can help the user obtain an insurance policy. The CNA reference does not teach the claimed limitation of "assigning said selected insurance agent to said insurance policy" as recited in Claim 4.

Given the defects of Mitcham and the CNA reference, there is simply no benefit to combine these references. Even if somehow these references were combinable, which combination Appellants specifically deny, their combination cannot teach the claimed invention. Moreover, the defects of the CNA reference cannot cure the defects of Mitcham. Whereas the CNA reference requires the user to first track down an insurance agent, Mitcham requires the user to enter various information through a kiosk to obtain an insurance policy. *See Mitcham* at Col. 4, lines 10-11. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See M.P.E.P.* § 2143.01, citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

b. Not All Claim Limitations Have Been Taught or Suggested by the
Combination of Mitcham and the CNA Reference

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 citing *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *Id.* Citing *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). The Examiner has failed to establish where the CNA reference teaches "assigning said selected insurance agent to said insurance policy," among many other things. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

2. Claim 5

Claim 5 is dependent on Claim 1 and recites that the act of re-intermediating an insurance agent comprises an act of providing a list of available insurance agents. The available insurance agents are identified based upon their geographical proximity to said individual. The method of Claim 5 further recites an act of receiving the selection of a selected agent from the list of available insurance agents; a further act of assigning said selected insurance agent to said insurance policies; a further act of transmitting information regarding said individual and said insurance policy to said selected insurance agent; and an additional act of remitting a commission to said selected insurance agent.

The Examiner has indicated that Mitcham fails to disclose the features recited in Claim 5 but that the CNA reference teaches a method similar to that recited in Claim 5. Appellants disagree for the following reasons: To locate a CNA branch office, according to page 11 of the CNA reference, a map is used by a user to locate a particular state in which the addresses of local CNA sales offices will then be displayed to the user. Assuming, for the sake of argument, that the CNA reference discusses the act of providing a list of available insurance agents, the CNA

reference does not perform the act of "assigning said selected insurance agent to said insurance policy," among other limitations of Claim 5. The user has to locate the CNA branch office and agent himself. The Examiner has failed to show where the CNA reference teaches "assigning said selected insurance agent to said insurance policy." Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claim 4 as if the discussed arguments were set forth here in full.

3. Claim 6

Claim 6 is dependent on Claim 1 and recites that the act of re-intermediating an insurance agent comprises an act of assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; a further act of assigning said assigned insurance agent to said insurance policy; a further act of transmitting information regarding said individual and said insurance policy to said assigned insurance agents; and an additional act of remitting a commission to said assigned insurance agent.

The Examiner has indicated that Mitcham and the CNA reference fail to disclose the features recited in Claim 6 but that the MostChoice reference teaches the method recited in Claim 6. Appellants disagree that the MostChoice reference teaches or suggests the method of Claim 6. The MostChoice reference is a collection of Web pages of a defunct Web site allowing a user to apply for an insurance policy or talk to "local advisors" regarding an insurance policy. Page 1 of the reference illustrates a table with two columns. The first column is described by the MostChoice reference as the offerings of independent insurance agents. In the second column of the table, the MostChoice reference distinguishes the offerings of independent insurance agents from "local advisors," who provide more services than those offered by independent insurance agents. The MostChoice reference does not teach the act of "assigning said selected insurance agent to said insurance policy," among other limitations of Claim 5. The Examiner has failed to

show where the CNA reference teaches "assigning said selected insurance agent to said insurance policy," among many other things. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claim 5 as if the discussed arguments were set forth here in full.

a. The Examiner Has Failed to Provide Authentic Evidence of Obviousness

The issues here fall into the difficult situation of prior art evidence. 35 U.S.C. § 102 specifically identifies three particular forms of prior art evidence whose authenticity may be conclusively presumed: patents, patent applications, and printed publications. These forms of evidence are maintained by impartial governmental facilities such as patent offices and libraries. It is virtually impossible to alter their content and it is a simple matter to establish their existence at an earlier time.

In the present situation, Appellants have no idea who prepared the Web documents received from the Examiner and whether the Web documents have been changed from the original. It is unclear whether the dates on these documents are publication dates. Appellants have only the Examiner to corroborate their authenticity, but, to date, the Examiner has refused to provide an Affidavit. In 1892, the U.S. Supreme Court reflected upon the class of evidence such as that received from the Examiner (*Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275):

The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined that they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny.

See 143 U.S. at 284.

b. The Examiner Cannot Use Unsubstantiated Knowledge to Supplant the Burden of Providing Trustworthy Evidence of Obviousness

The Examiner maintains that "[t]he MostChoice Web site, consisting of a plethora of linked Web pages, 12 of which are used as references, was actively maintained during the period cited, and teaches the claimed elements as analyzed and discussed in a prior Office Action and in the current Office Action." It is unclear to Appellants how the Examiner is able to divine that the Web site cited in the MostChoice reference was "actively maintained." Even if the Web site was actively maintained, there is nothing that suggests one would have been able to obtain a quote on-line. Unless one can obtain a quote on-line, it is difficult to understand how an insurance agent can be re-intermediated in a process by which the insurance agent can be assigned the insurance policy. The Examiner did not point to any source that could substantiate that the Web site was actively maintained or that a quote was obtainable on-line.

As discussed above, an attempt was made to select a hyperlink that would lead a user to a Web page to apply for an insurance quote on-line at the Web site "www.mostchoice.com" archived at the Web site "web.archive.org." Instead of receiving a Web page for filling out information to obtain an insurance quote, Appellants received a Web page displaying the text "Under Construction." This "Under Construction" Web page belongs to MostChoice.com, Inc., and not the archive Web site "web.archive.org". Appellants have accessed the present-day Web site "www.mostchoice.com," and the present-day Web site "www.mostchoice.com" continues to not allow anyone to purchase an insurance policy according to a bindable insurance premium quotation, and in response to such a request, re-intermediate an insurance agent and issue the insurance policy. The Examiner dismissed these actions of Appellants to clarify the MostChoice reference as mere "discovery by [Appellants] of one Web page listed as 'Under Construction' today neither proves nor disproves the enablement of these Web pages at the time the invention was made." See the August 12, 2003, final Office Action, page 10.

There is danger in the position maintained by the Examiner. The very Web page of the MostChoice reference that would have revealed whether it teaches the ability to obtain an insurance quote is "Under Construction." The issue here is disclosure and the MostChoice reference lacks the disclosure necessary to teach the various subject matters of the claimed invention. The Examiner has stated that "[a]s is well known in the art, archived Web pages are frequently not maintained to the present day." This may well be true, but it is still the responsibility of the Examiner to come forward with trustworthy evidence of obviousness. Appellants' claimed invention cannot be rejected based on the excuse that Web pages are frequently not maintained to the present day.

The Examiner has indicated that "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. § 103," citing *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569 (Fed. Cir. 1991). In Appellants' view, a reference that lacks enabling disclosure "may qualify as a prior art reference under § 103, but only for what is disclosed in it." See *Reading & Bates Constr. Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 652, 223 U.S.P.Q. (BNA) 1168, 1173 (Fed. Cir. 1984). The MostChoice reference cannot qualify as prior art for what is hidden in an "Under Construction" Web page.

c. The Examiner Has Insisted That Somehow the MostChoice Reference
Must Teach Appellants' Invention, Despite Evidence to the Contrary

One of the features recited in Claim 6 is "assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual ... [and] transmitting information regarding said individual and said insurance policy to said assigned insurance agent. It is true that a user may call an advisor discussed in the MostChoice reference to obtain a quote." In such a situation, there would be no need for assigning an insurance agent since the user makes the initial contact.

There is a mention in the MostChoice reference that a user could apply for an insurance quote on-line. (But the attempt to do this by Appellants failed, as discussed above.) Whether this insurance quote is a bindable insurance quote is never stated by the MostChoice reference. Moreover, no teaching of re-intermediating an insurance agent is found in the MostChoice reference. Thus, it cannot be possible for the MostChoice reference to execute the act of "assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual ... [and] transmitting information regarding said individual and said insurance policy to said assigned insurance agent."

The Examiner argued that "[e]ven if [the MostChoice reference] discloses an inoperative device, it is prior art for all that it teaches." See the August 12, 2003, final Office Action, page 10. However, the Examiner has failed to point out where it is that the MostChoice reference teaches the claimed invention. The MostChoice reference attempted to teach that a user can obtain a quote on-line, but this is not the claimed invention. The MostChoice reference also allows a user to call an advisor directly, but that is also not the claimed invention.

- d. To Combine the References, the Approach of Mitcham Must Be Jettisoned, or the Approach of the CNA Reference Must Be Abandoned, or the Approach of the MostChoice Reference Must Be Disposed of, and the Combination Would Destroy the Operation of All the References

As discussed above, Mitcham has failed to teach "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy" among other limitations, as recited in Claims 1 and 19. The user cannot request to purchase an insurance policy according to a bindable insurance premium quotation through the Web site described by the CNA reference. There can be no re-intermediation in the system described by the CNA reference because the user must first track down a CNA insurance agent before the CNA

insurance agent can help the user obtain an insurance policy. Like the CNA reference, the MostChoice reference does not function to allow a user to obtain a quote on-line, let alone a bindable insurance premium quotation.

Given the defects of Mitcham, the CNA reference, and the MostChoice reference, there is simply no benefit to combine these references. Even if somehow these references were combinable, which combination Appellants specifically deny, they do not teach the claimed invention for the reasons stated above. Moreover, the teaching of the CNA reference cannot cure the defects of Mitcham and the teaching of the MostChoice reference cannot cure the defects of the CNA reference or the defects of Mitcham. Whereas the CNA reference requires the user to first track down an insurance agent, Mitcham requires the user to enter various information through a kiosk to obtain an insurance policy "without the need for interacting with a representative of an insurance company." See Mitcham at Col. 4, lines 10-11. The MostChoice reference does not even allow the user to apply for an insurance quote, let alone a bindable insurance quote. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

The Examiner has not provided a proper motivation to combine these references. The Examiner copied bits and pieces from the CNA reference and the MostChoice reference and declared that there is motivation. The selected portions of the CNA reference and the MostChoice reference provide no rationale for the Examiner to modify the references. Although a prior art device may be capable of being modified, there must be suggestion or motivation in the reference to do so. See M.P.E.P. § 2143.01 citing favorably *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Consequently, no *prima facie* case of obviousness has been established by the Examiner.

4. Claim 7

Claim 7 is dependent on Claim 6 and recites that the said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

The Examiner has indicated that Mitcham and the CNA reference fail to disclose the features recited in Claim 7, but that the MostChoice reference teaches the method recited in Claim 7. The MostChoice reference is a collection of Web pages of a Web site allegedly allowing a user to apply for an insurance policy or talk to "local advisors" regarding the insurance policy. Page 1 of the reference illustrates a table with two columns. The first column is described by the MostChoice reference as the offerings of independent insurance agents. In the second column of the table, the MostChoice reference distinguishes the offerings of independent insurance agents from "local advisors," who provide more services than those of independent insurance agents. The MostChoice reference does not teach or suggest the feature of "said assigned insurance agent comprises the geographically closest available insurance agent to said customer," among other limitations of Claim 7. Since the applied references do not teach or suggest each limitation of Claim 7, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the discussed arguments in connection with Claim 6 as if the discussed arguments were set forth here in full.

5. Claim 8

Independent Claim 8 is directed to a system for providing an insurance policy via a distributed computing network, which is recited as comprising a server computer, which maintains a virtual insurance producer Web site available via said distributed computing network. The virtual producer Web site is operative to receive a request for a bindable premium quotation for an insurance policy and to receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be

provided by said insurance policy in response to said request. The virtual producer Web site is further operative to gather underwriting information from one or more outside information resources based upon the identity of said individual and determine whether said insurance policy may be underwritten. The virtual producer Web site is additionally operative to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation. The virtual producer Web site is also operative to receive a request to purchase said insurance policy according to said bindable insurance premium quotation, re-intermediate an insurance agent, and issue said insurance policy.

Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach the feature of "a server computer maintaining a virtual insurance producer Web site available via said distributed computing network, and wherein said virtual producer Web site is operative to ... receive a request to purchase said insurance policy according to said bindable insurance premium quotation [and] re-intermediate an insurance agent," among other limitations of Claim 8. The kiosk of Mitcham is not a server on which a virtual insurance producer Web site is maintained. Neither the CNA reference nor the MostChoice reference allows the act of receiving a request to purchase said insurance policy according to said bindable insurance premium quotation and re-intermediating an insurance agent. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-7, and 19 as if the discussed arguments were set forth here in full.

6. Claim 10

Claim 10 is dependent on Claim 8 and recites that the virtual producer Web site is further operative to provide an interactive help system to a requestor of said insurance policy. Appellants are unable to find and the Examiner has failed to show where Mitcham, the CNA

reference, and the MostChoice reference, either alone or in combination, teach or suggest the feature of "provide an interactive help system to a requestor of said insurance policy," among other limitations of Claim 10. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, and 19 as if the discussed arguments were set forth here in full.

7. Claim 11

Claim 11 is dependent on Claim 10 and recites that the interactive help system comprises an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of "an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative," among other limitations of Claim 11. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10, and 19 as if the discussed arguments were set forth here in full.

8. Claim 12

Claim 12 is dependent on Claim 11 and recites that the interactive help system further comprises an e-mail facility for providing an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of an e-mail facility for providing an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative," among other limitations of Claim 12. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-11, and 19 as if the discussed arguments were set forth here in full.

9. Claim 13

Claim 13 is dependent on Claim 12 and recites that the interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach the feature of "a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance," among other limitations of Claim 13. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-12, and 19 as if the discussed arguments were set forth here in full.

10. Claim 14

Claim 14 is dependent on Claim 8 and recites that the virtual producer Web site is further operative to issue said insurance policy, which comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of "issue said insurance policy, which comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy," among other limitations of Claim 14. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-13, and 19 as if the discussed arguments were set forth here in full.

11. Claim 15

Claim 15 is dependent on Claim 14 and recites that the virtual producer Web site is further operative to re-intermediate an insurance agent, which comprises providing a list of available insurance agents; receiving the selection of a selected agent from the list of available insurance agents; assigning said selected insurance agent to said insurance policy; transmitting information regarding said individual and said insurance policy to said selected insurance agent; and remitting a commission to said selected insurance agent. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of "assigning said selected insurance agent to said insurance policy," among other limitations of Claim 15. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-14, and 19 as if the discussed arguments were set forth here in full.

12. Claim 16

Claim 16 is dependent on Claim 14 and recites that the virtual producer Web site is further operative to re-intermediate an insurance agent, which comprises providing a list of available insurance agents. The available insurance agents are identified based upon their geographical proximity to said individual. Claim 16 further recites receiving the selection of a selected agent from the list of available insurance agents; assigning said selected insurance agent to said insurance policy; transmitting information regarding said individual and said insurance policy to said selected insurance agent; and remitting a commission to said selected insurance agent. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of "assigning said selected insurance agent to said insurance policy," among other limitations of Claim 16. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-15, and 19 as if the discussed arguments were set forth here in full.

13. Claim 17

Claim 17 is dependent on Claim 14 and recites that the virtual producer Web site is operative to re-intermediate an insurance agent; this comprises assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual; assigning said assigned insurance agent to said insurance policy; transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and remitting a commission to said assigned insurance agent. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of "assigning said selected insurance agent to said insurance policy," among other limitations of Claim 17. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-16, and 19 as if the discussed arguments were set forth here in full.

14. Claim 18

Claim 18 is dependent on Claim 17 and recites that the assigned insurance agent comprises the geographically closest available insurance agent to said customer. Mitcham, the CNA reference, and the MostChoice reference, either alone or in combination, do not teach or suggest the feature of "the geographically closest available insurance agent to said customer," among other limitations of Claim 18. Accordingly, the Examiner has not established a *prima facie* case of obviousness.

Appellants incorporate by reference the arguments discussed in connection with Claims 1, 3-8, 10-17, and 19 as if the discussed arguments were set forth here in full.

D. A Recap of the Claimed Invention Clearly Shows That None of the Applied References Teaches, Let Alone Renders Unpatentable, the Claimed Invention

Clearly neither Mitcham, the CNA reference, nor the MostChoice reference, alone much less in combination, teaches or suggests the subject matter of Claim 1. More specifically, none of these references, alone much less in combination, teaches or suggests "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in Claim 1. As will be readily appreciated from the foregoing discussion, none of the three applied references teaches or suggests the subject matter of Claim 1. As a result, Appellants submit that Claim 1 is clearly allowable in view of the teachings of the references.

With respect to Claims 3-7, all of which depend directly or indirectly from Claim 1, it is clear that the subject matter of these claims is also neither taught nor suggested by the applied references, namely, Mitcham, the CNA reference, or the MostChoice reference. Claims 3-7 all have limitations that are clearly neither taught nor suggested by any of the applied references, particularly when the limitations are considered in combination with the recitations of the claims from which these claims individually depend. In summary, Claims 3-7 are submitted to be allowable for reasons in addition to the reasons why Claim 1 is submitted to be allowable.

Independent Claim 8 is directed to a system. Among other differences, none of the applied references teaches the feature "receive a request to purchase said insurance policy according to said bindable insurance premium quotation, re-intermediating an insurance agent, and issuing said insurance policy," as recited in Claim 8. For generally the same reasons discussed above with respect to Claim 1, Appellants submit that the subject matter of Claim 8 is neither taught nor suggested by the applied references, and thus, Claim 8 is also allowable.

With respect to dependent Claims 10-18, all of which depend directly or indirectly from Claim 8, it is also clear that the subject matter of these claims is neither taught nor suggested by

the applied references, namely, Mitcham, the CNA reference, or the MostChoice reference. Claims 10-18 all have limitations that are clearly neither taught nor suggested by any of the applied references, particularly when the limitations are considered in combination with the recitations of the claims from which these claims individually depend. In summary, Claims 10-18 are submitted to be allowable for reasons in addition to the reasons why Claim 8 is submitted to be allowable.

Independent Claim 19 is directed to a computer-readable medium. In many ways, the subject matter of independent Claim 19 mirrors the subject matter of the system recited in Claim 8 and the method recited in Claim 1, albeit in a different manner. For reasons generally similar to reasons discussed above with respect to Claims 1, 3, 4, 5, 6, and 7, Claim 19 is submitted to recite subject matter that is clearly neither taught nor suggested by the applied references. Specifically, none of the applied references teaches or even suggests "receiving a request to purchase said insurance policy according to said bindable insurance premium quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy," as recited in Claim 1. As a result, Appellants respectfully submit that Claim 19 is allowable.

In light of the foregoing remarks, it is clear that none of the applied references teaches, let alone renders unpatentable, the claimed inventions recited in Claims 1, 3-8, and 10-19. The applied references are all directed to either having a user directly contact an insurance representative without re-intermediating or having the user apply for an on-line quotation that is not a bindable premium quotation; work in an entirely different manner from the present invention; or have nothing to do with the present invention. The present invention is directed to an entirely different concept and solution. The present application is directed to "receiving a request to purchase said insurance policy according to said bindable insurance premium

quotation, and in response to said request, re-intermediating an insurance agent and issuing said insurance policy."

In view of the foregoing remarks, Appellants submit that all of the claims in the present application are patentably distinguishable over the teachings of Mitcham, the CNA reference, and the MostChoice reference. Therefore, it is submitted that the rejections of Claims 1, 3-8, and 10-19 were erroneous, and reversal of the rejections is respectfully requested.

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VIII. CLAIMS APPENDIX

1. A method for providing an insurance policy via a distributed computing network, comprising:

receiving a request for a bindable premium quotation for an insurance policy;

in response to said request, receiving information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy;

gathering underwriting information from one or more outside information resources based upon the identify of said individual;

determining whether said insurance policy may be underwritten;

in response to determining that said insurance policy may be underwritten, calculating a premium for said insurance policy and providing said premium to a requestor of said premium quotation as a bindable insurance premium quotation;

receiving a request to purchase said insurance policy according to said bindable insurance premium quotation; and

in response to said request, re-intermediating an insurance agent and issuing said insurance policy.

2. (Canceled)

3. The method of Claim 1, wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

4. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

5. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

6. The method of Claim 1, wherein re-intermediating an insurance agent comprises:

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

assigning said assigned insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and

remitting a commission to said assigned insurance agent.

7. The method of Claim 6, wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

8. A system for providing an insurance policy via a distributed computing network, comprising:

a server computer maintaining a virtual insurance producer Web site available via said distributed computing network, and wherein said virtual producer Web site is operative to:

receive a request for a bindable premium quotation for an insurance policy;

receive information relating to the insurability of an individual to be insured by said insurance policy and information relating to the coverage to be provided by said insurance policy in response to said request;

gather underwriting information from one or more outside information resources based upon the identify of said individual;

determine whether said insurance policy may be underwritten;

to calculate a premium for said insurance policy and to provide said premium to a requestor of said premium quotation as a bindable insurance premium quotation;

receive a request to purchase said insurance policy according to said bindable insurance premium quotation;

re-intermediate an insurance agent; and
issue said insurance policy.

9. (Canceled)

10. The system of Claim 8, wherein said virtual producer Web site is further operative to:

provide an interactive help system to a requestor of said insurance policy.

11. The system of Claim 10, wherein said interactive help system comprises an interactive chat facility for providing real-time communication between said requestor of said insurance policy and an insurance help-desk representative.

12. The system of Claim 11, wherein said interactive help system further comprises an e-mail facility for receiving an electronic mail message from said requestor of said insurance policy and transmitting said message to an insurance help-desk representative.

13. The system of Claim 12, wherein said interactive help system further comprises a facility for notifying an insurance help-desk representative that said requestor of said insurance policy would like to receive a telephone call providing assistance.

14. The system of Claim 8, wherein issuing said insurance policy comprises transmitting an electronic version of said insurance policy to an individual insured by said insurance policy.

15. The system of Claim 14, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

16. The system of Claim 14, wherein re-intermediating an insurance agent comprises:

providing a list of available insurance agents, said available insurance agents identified based upon their geographical proximity to said individual;

receiving the selection of a selected agent from the list of available insurance agents;

assigning said selected insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said selected insurance agent; and

remitting a commission to said selected insurance agent.

17. The system of Claim 14, wherein re-intermediating an insurance agent comprises:

assigning an insurance agent to said insurance policy based upon the geographical proximity of said insurance agent to said individual;

assigning said assigned insurance agent to said insurance policy;

transmitting information regarding said individual and said insurance policy to said assigned insurance agent; and

remitting a commission to said assigned insurance agent.

18. The system of Claim 17, wherein said assigned insurance agent comprises the geographically closest available insurance agent to said customer.

19. A computer-readable medium containing computer-executable instructions which, when executed by a computer, cause the computer to perform the method of Claims 1, 3, 4, 5, 6, or 7.

IX. EVIDENCE APPENDIX

-NONE-

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X. RELATED PROCEEDINGS APPENDIX

-NONE-

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in triplicate with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: February 22, 2005

Cindy A. Norton

DPC:clm